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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,184	05/24/2001	John F. Breedis	102134-100	2996

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WIGGIN & DANA LLP
ATTENTION: PATENT DOCKETING
ONE CENTURY TOWER, P.O. BOX 1832
NEW HAVEN, CT 06508-1832

[REDACTED] EXAMINER

IP, SIKYIN

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1742

DATE MAILED: 08/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 6/4/02

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1 - 24 is/are pending in the application.

Of the above claim(s) 12 - 20 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1 - 11, 21 - 24 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of claims 1-11 in Paper No. 4, filed on June 4, 2002 is acknowledged. The traversal is on the ground(s) as set forth in page 3 of said paper. This is not found persuasive because as are evinced by references of record, the claimed alloy could be produced by different method steps.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 12-20 are drawn to an invention nonelected with traverse in Paper No. 4, filed on June 4, 2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The limitation in claims 21-24 is unclear whether the claimed alloy is being treating or was treated in a relief anneal temper step.

Claim Rejections - 35 USC § 103

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-11 and 21-24 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 11-264037 (PTO-1449, abstract and Table 1, samples 1-8) or JP 61266540 (abstract and Table 1 in page 2).

9. The cited reference(s) disclose(s) the features including the claimed Cu base alloy composition, electrical conductivity, and/or tensile/hardness properties. The difference between the reference(s) and the claims are as follows: with respect to claim 10, that cited references do not disclose the remaining stress at 150°C after 3000 hours exposure. However, since the alloys of cited references have alloy

composition and tensile property at an ambient temperature overlap the claimed alloy, it is believed that the remain stress at the claimed condition would be overlapped. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spade*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) and *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).”

10. JP 11-264037 in the Table discloses tensile strength instead of yield strength, but yield strength is about 90% of tensile strength which is within the claimed range.
11. The hardness value disclosed by JP 61266540 is proportional to yield strength. Thus, the improvement of hardness value means improvement of yield strength.
12. With respect to the relief anneal temper step in claims 21-24 that the invention defined in a product-by-process claim is a product, not a process. *In re Bridgeford*, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966).

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claims above, and further in view of USP 4605532 to Knorr et al (PTO-1449, abstract and all Tables).

14. The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for both yield strength and electrical conductivity. However, Knorr in tables teaches the Cu base alloys of cited references could obtain the claimed yield strength and electrical conductivity in the same field of endeavor. It is well settled that a composition which is old has been treated by an old and well known method is unpatentable over the prior art composition in the untreated state. In re Beck, et al., 69 USPQ 520.

Response to Arguments

15. Applicant's arguments filed June 4, 2002 have been fully considered but they are not persuasive.

16. Applicants argue that none of the example in JP '037 contains Ni. However, it is well settled that the examples of the cited reference are given by way of illustration and not by way of limitation. In re Boe, 148 USPQ 507 (CCPA 1966) and In re Snow, 176 USPQ 328.

17. Applicants' argument as set forth in paragraph bridging pages 4-5 of the

instant remarks is noted. But, page 10, Table 3 of the instant specification does not clearly show Co is detrimental. Comparison must be done under identical condition except for the novel features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791, 792 (Fed. Cir. 1971), In re Coleman, 205 USPQ 1172, and In re Greenfield, 197 USPQ 227.

18. Applicants' argument with respect to the relief anneal temper is noted. But, it is unclear that said relief anneal temper step is the sole step to contribute the claimed properties. It is apparent that the claimed electrical conductive and tensile strength are possessed by alloys of cited references.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

S. YIN IP
PRIMARY EXAMINER